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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/555,479	11/03/2005	Wolfgang Hirschburger	3455	7000

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EXAMINER

SELF, SHELLEY M

ART UNIT PAPER NUMBER

3725

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/555,479

Applicant(s)

HIRSCHBURGER ET AL.

Examiner

Shelley Self

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/3/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings and specification are replete with errors wherein different reference numbers are used to describe more than one single element, elements are not listed in either the specification or the drawings. Further, the brief description lists a figures 6, however no figure 6 is included in the drawings. Examiner further notes that two different drawings are annotated as figure 5. Clarification is required.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because the following elements have been designated by multiple reference characters:

"32" and "34" turbine wheel (Pg. 5)

"28" and "29" air-conveying elements (Pg. 5, lines 29; Pg. 6, lines 5)

The following reference characters have been used to designate multiple elements:

"34" turbine wheel (pg. 5) guide ring (pg. 6)

"29" air-conveying elements (pg. 5), intermediate spaces (pg. 6)

Additionally the following have been defined within the written disclosure 16, 38 & 260.

Also the following reference characters are defined within the written specification but are not illustrated in the drawings: 48, 231 7 301.

The claimed subject matter has not been illustrated, i.e. no vacuum cleaner (clm. 1) is illustrated within the drawings.

Examiner notes the drawing objections listed above are not inclusive, Applicant is required to review all drawings and written disclosure for clarity and proper correlation between the drawings and the written disclosure.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

With regard to the specification, page 1, lines 5-6 and 19, the reference to claim 1 is not clear. As set forth by CFR 1.71(a), the specification must include a written description of the invention or discovery and of the manner and process of making and using the same, further CFR 1.71(b) states, "The specification must set forth the precise invention for which a patent is solicited..." The reference to claim 1 should be replaced with a clear recitation for which is meant by the reference to claim 1.

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

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The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The Abstract includes legal phraseology, "*comprising*" that should be avoided.

Appropriate correction is required.

Claim Objections

Claims 4-10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim may not serve as a basis for which a multiply dependent claim depends from, i.e., because claim 2 is a multiple dependent claim, no multiply dependent claim may depend from claim 2. See MPEP § 608.01(n). Accordingly, the claims 4-10 have not been further treated on the merits.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With regard to claim 1, it is not clear what is meant by, "it is possible to operate in the intended manner by..." what is the intended manner, no intended manner has been positively recited. The recitation, "it" (line 1) renders the claim vague, i.e., what is "it". Examiner suggests, --attached to said housing--

Further regarding claim 1, the recitation, "*in particular*" renders the claim indefinite, because it is unclear whether the limitations following the phrase are part of the claimed invention, i.e. is an inlet and outlet grate and vacuum cleaner being positively recited? Are the elements a part of the claimed invention? Additionally regarding the recitation, "*in particular by means of a vacuum cleaner...*" it is not clear^{as} to whether or not it is the vacuum cleaner that has a suction air-drivable turbine with a radial or Pelton turbine wheel or if it is the router that has these elements. Clear and positive recitation of all critical mechanical interrelationships between elements is suggested. The claim appears to be written more in the form of an Abstract as opposed to a proper apparatus claim, rendering a clear understanding of the claimed invention highly difficult. Clarification is required.

The following regarding claim 1 does not have clear antecedent basis: "*the drive*".

Regarding claim 1, the word "means" is preceded by the word(s) "manner by (lines 2-3)", "in particular by (line 3)" and "another by (line 8)" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967). Accordingly it is unclear as to whether or not Applicant is invoking 35 U.S.C. 112 6th paragraph. Examiner suggests, "*means for...*" Clarification is required.

With regard to claim 2, reference character (14) is used to signify a lower region, however this reference character was utilized in claim 1 to signify a "tube-like" member, it is not

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clear what is being claimed here. Further there is no antecedent basis for the recitation, “the lower region”, the lower region of what?, the housing? tool? Clarification is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 as best as can be understood are rejected under 35 U.S.C. 102(b) as being anticipated by Walton, II (4,281,457). Walton discloses a hand tool/router having a housing and tool attached to the housing (fig. 1) wherein the housing encompasses the tool (fig. 1) a turbine (figs. 1-4), inlet and outlet grating and drive operated by a vacuum source (Abstract; fig. 4); there grating in the form of curved vanes (fig. 3).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shelley Self whose telephone number is 571-272-4524. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Derris Banks can be reached on 571-272-4419. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SSelf

October 15, 2006